

REMARKS

In the Office Action the Examiner noted that claims 1-12 are pending in the application. The Examiner rejected claims 1-9, and objected to claims 10-12. By this Amendment, claims 1-12 have been amended, and new claims 13-15 have been added. No new matter has been presented. Thus, claims 1-15 are pending in the application. The Examiner's rejections and objections are traversed below, and reconsideration of all claims is respectfully requested.

Request To Withdraw Finality of Office Action

In the Amendment filed on August 17, 2005, the Applicants made several arguments as to why there was no motivation to combine the references cited in the Examiner's 35 U.S.C. §103(a) rejections. In the Examiner's Response to Arguments in item 3 on page 5 of the current Office Action, the Examiner simply states that "[m]otivations for combining references have been presented clearly in the rejection. Applicant has not presented any proper reason against the motivation." The Applicants respectfully submit that this is not an adequate address of the traversals of the Examiner's rejections.

MPEP 707.07(f) states that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." In the Amendment filed on August 17, 2005, the Applicant made the following traversals of the Examiner's §103 rejections:

Further, even if the cited references did combine to disclose all of the features of claim 1 of the present application, and the Applicants respectfully submit that they do not, there is no motivation to combine the cited references. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that "[o]ne of ordinary skill in the art would have been motivated to use the resonator taught by Park et al to replace Morinaga's resonator thus effectively reducing the vibration (noise) generated in the device." However, as previously discussed, there is no resonator disclosed in Morinaga, and therefore there is no resonator to replace. And, further, as the damper of Morinaga is apparently only coupled to the disk tray because of the dual supporting capability of the damper, the fact that the mass body and connection member of Park are provided to the deck plate, rather than the disk tray, actually teaches away from the combination of the cited references. Also, the mechanical operation of the flexibly changeable connection member connected to the mass body necessitates being connected to the disk tray, which also teaches away from combining the cited references.

The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding

the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). Therefore, due to the facts that the combination of the two cited references do not disclose the features of claim 1 of the present application, and further that the disclosure of Park actually teaches away from the combination of the cited references, the Applicants again respectfully request the withdrawal of the §103 rejection of claim 1.

The Applicants submit that these arguments provide valid reasons which indicate why the two cited references would not be combined, and in fact teach away from each other. Therefore, the Applicants respectfully request that the Examiner withdraws the finality of the current Office Action, and further provide a proper response which addresses the substance of the Applicants' arguments.

Entry of Amendment Under 37 C.F.R. §1.116

The Applicant requests entry of this Rule 116 Response because: the amendments were not earlier presented because the Applicant believed in good faith that the cited references did not disclose the present invention as previously claimed; the amendment of claims 1-12 should not entail any further search by the Examiner since no new features are being added and no new issues are being raised; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Claim Rejections Under 35 USC §103

In item 1 on pages 2-4 of the Office Action the Examiner rejected claims 1-9 under 35

U.S.C. §103(a) as being unpatentable over Morinaga (JP 8-203259A) in view of Park (EP 1 207 532 A2). The Applicants respectfully traverse these rejections.

Claim 1 of the present application, as amended, recites a “disk tray comprising two or more resonators mounted on a lower surface of the disk tray to selectively reduce noise of at least two predetermined frequency bands.” Support for this amendment can be found in at least paragraphs [0038] through [0041] of the present application. No new matter has been presented through these amendments. The Applicants respectfully submit that the disk tray recited in claim 1 of the present application is not disclosed by the cited references, either separately or in combination.

As stated in the Amendment of August 17, 2005, the Applicants respectfully submit that there is no motivation to combine Morinaga and Park, and that the references actually teach away from each other. The Examiner has yet to properly address this argument.

However, assuming arguendo that there is motivation to combine the two references, neither of the references disclose a plurality of resonators to selectively reduce noise of at least two predetermined frequency bands. Therefore, the Applicants respectfully submit that claim 1 of the present application patentably distinguishes over the cited references.

Claims 2-4 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 2-4 also patentably distinguish over the cited references.

Claim 5 of the present application, as amended, recites “two or more resonators installed on a lower surface of the disk tray to selectively reduce noise of at least two predetermined frequency bands.” As previously discussed, the cited references, either alone or in combination, do not disclose at least this feature of claim 5. Therefore, it is respectfully submitted that claim 5 also patentably distinguishes over the cited references.

Claims 6-8 depend from claim 5 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 6-8 also patentably distinguish over the cited references.

Claim 9 of the present application, as amended, recites a resonator system having a plurality of resonators “wherein at least two of the resonators respectively reduce noise of two different frequency bands.” As previously discussed, the cited references, either alone or in combination, do not disclose at least this feature of claim 9. Therefore, it is respectfully submitted that claim 9 also patentably distinguishes over the cited references.

Allowable Subject Matter

In item 2 on pages 5-6 of the Office Action the Examiner objected to claims 10-12 as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As discussed in the previous section of this Amendment, claim 9 patentably distinguishes over the cited references. Further, claims 10-12 depend from claim 9 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 10-12 also patentably distinguish over the cited references.

New Claims 13-15

New claims 13-15 contain the subject matter of original claims 9-12, which the Examiner objected to as being dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. New claim 13 contains the subject matter of original claims 9 and 10, and new claims 14 and 15 contain the subject matter of original claims 11 and 12, respectively. Therefore, it is respectfully submitted that new claims 13-15 patentably distinguish over the cited references.

Summary

In accordance with the foregoing, claims 1-12 have been amended, and new claims 13-15 have been added. No new matter has been presented. Claims 1-15 are pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

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Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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